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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/555,551 | 08/29/2000 | Jonathan B. Orlick | ST/044 | 8362 |
| 7590 Alexander Shvarts Fish & Neave 1251 Avenue of the Americas New York, NY 10020-1105 | | 12/13/2007 | EXAMINER LONSBERRY, HUNTER B | |
| | | | ART UNIT 2623 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/555,551

Applicant(s)

ORLICK, JONATHAN B.

Examiner

Hunter B. Lonsberry

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12,13,15-19,21 and 24-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12,13,15-19,21 and 24-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

In view of the Appeal Brief filed on 6/7/07, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 12-13, 15-19, 21, 28-30, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A 1 of record) in further view of Alexander (US 6,177,931).

As to claim 1, note the Ellis et al. reference that discloses an electronic television program guide schedule system and method with remote product ordering. The claimed "a television program schedule database" is met by "[t]he microcontroller 16 uses the received program schedule information to build a database by storing the data in appropriately organized records in dynamic random access memory (DRAM) 18" (Ellis [0097]). The claimed "comprising television program schedule information, informational messages, and information links that link the informational messages to the television program schedule information" is met by "[t]he schedule information [...] includes the name of the program and program start/stop time" (Ellis [0129]) and "the microcontroller first searches the program schedule database in, for example, the DRAM 18 to retrieve the programming information for the currently tuned channel 52 corresponding to the current time..." (Ellis [0119]) and in the BROWSE mode "a graphic overlay 111 is generated, as in the FLIP mode, with program schedule information for the currently tuned channel 112..." (Ellis [0126]) wherein it is inherent that the television program schedule information and informational messages be linked in order for them to be properly displayed to the user. Note, the Ellis et al. reference discloses that the BROWSE feature may incorporate advertisements (Ellis [0127]).

The claimed "and television equipment configured to: display a television program on a substantially full portion of a display monitor" is met by "[i]n the BROWSE mode, the user is provided with the ability to scan through program schedule information for any channel, including, but not limited to, the channel being viewed, while at the same time continuing to view the TV program previously selected" (Ellis [0126]). The claimed "select an informational message from the television program schedule database that is linked to the television program schedule information by the information link" is met by the selecting of the corresponding program information (informational message) from the television program schedule database (Ellis [0119,0126-0129]). The claimed "display a pop up window overlaid on the displayed television program" is met by the display of a graphic overlay while at the same time continuing to view the TV program previously selected (Ellis [0126]).

However, the Ellis et al. reference is silent as to how the advertisements are incorporated into the BROWSE feature.

Alexander discloses a targeted advertising system which overlays video data by packet matching overlay data specified for a specific zipcode, and a user, upon initial startup of the device may input the zipcode, likewise advertisements may be narrowcast customized messages (column 32, lines 7-21, 35-60), advertisements may have content codes which are used to match category labels (column 33, lines 44-65), all the users viewing habits may be monitored locally and targeted ads may be stored locally, the monitoring enabling targeted ads based off users interests and viewing history to provide the most appropriate ads as well as additional content which matches a users

interest (column 29, lines 14-column 30, line 44, column 31, lines 48-61, column 34, lines 10-25),.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Ellis to utilize the zipcode matching, targeted advertising, and content seeking features as taught by Alexander for the advantages of providing advertisements which are geographically relevant, and match the users ongoing interests and provide the user with other content which is of most interest to a user.

The claimed "the pop up window including the selected advertising message and the selected informational message" is met by the Ellis et al. and Alexander et al. combination as discussed above teaching an overlay (pop up window) including advertisements. The claimed "wherein the television program is simultaneously displayed with both the informational message and the advertising message" is met by displaying an overview while at the same time continuing to view the TV program previously selected" (Ellis [0126]).

As to claim 3, the claimed "wherein the selected informational message relates to the displayed television program" is met by "a graphic overlay 111 is generated, as in the FLIP mode, with program schedule information for the currently tuned channel 112" (Ellis [0126]).

As to claim 4, the claimed "wherein the selected informational message relates to later programming on a channel of the displayed television program" is met by "[i]n

order to view programming information for later or earlier times, the user employs the left and right direction arrows 43B. As a consequence, the system will display future program schedule information for the particular channel previously selected by the up and down direction arrows, whether it is the channel currently being viewed or any other available channel" (Ellis [0129]).

As to claim 5, please see rejection of claim 3.

As to claim 6, the claimed "further comprising displaying a composite of an EPG and an advertising message overlaid on the displayed television program" is met by the Ellis et al. and Alexander et al. combination as discussed in the rejection of claim 1.

As to claim 7, the claimed "further comprising displaying an EPG overlaid on the displayed television program" is met by "the user is provided with the ability to scan through program schedule information for any channel, including, but not limited to, the channel being viewed, while at the same time continuing to view the TV program previously selected" (Ellis [0126]).

As to claim 12, the claimed "in which the selected advertising message is about a product or service" is met by the Ellis et al. and Zigmond et al. combination as discussed in the rejection of claim 1 wherein ads may comprise goods or service

(Zigmond 14:25-26).

As to claims 13, 15-19, and 21, please see rejections of claims 1, 3-7, and 12 respectively.

As to claim 28, please see rejection of claim 1.

As to claim 29, the claimed "wherein a different advertising message is selected each time the pop up window is displayed." The Ellis et al. reference does not specifically disclose the display of a different advertising message each time the pop up window is displayed. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to display different advertisements to users for the purpose of maximizing advertising revenue and to increase the likelihood that a user will view and advertised product or service of interest to the viewer and for the further purpose of providing variety to a user. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. display electronic program guide overlay with advertisements accordingly for the above stated advantages.

As to claim 30, the claimed "wherein a different advertising message is selected and displayed after a predetermined time." The Ellis et al. reference does not specifically disclose the display of a different advertising message after a predetermined

time. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to replace advertisements for the purpose of maximizing advertising revenue and to increase the likelihood that a user will view and advertised product or service of interest to the viewer and for the further purpose of providing variety to a user.

Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. display electronic program guide overlay with advertisements accordingly for the above stated advantages.

As to claim 35-37, please see rejection of claim 28-30 respectively.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al.

(US 2003/0204847 A 1 of record) in view of Alexander (US 6,177,931_ and Alten et al. (US 5,635,978 of record).

As to claim 8, note the Ellis et al. and Alexander et al. combination distributing non-video program guide and advertising data to set top boxes where it is stored.

However, the Ellis et al. reference is silent as to the storage of EPG data including background color.

Now note the Alten reference that discloses the storage of bitmaps in the system for use as "mood background" viewing (Alten 11:34-38). Alten specifically discloses the

use of a "nighttime view" (Alten 11:42) and (Fig. 5c) as an example. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. EPG display with the Alten et al. background coloring for the purpose of easing the monotony of viewing program listings.

As to claim 9, please see rejection of claim 8.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US2003/0204847 A 1 of record) in further view of Alexander et al. (US 6,177,931), Alten et al. (US 5,635,978 of record), and Marshall et al. (US 5,828,420 of record).

As to claim 10, note the Ellis et al., Alexander and Alten et al. combination teaches an EPG guide including stored background color values. However, the Ellis et al. Alexander, and Alten et al. combination is silent as to the use of a transparent value for the background color.

Now note the Marshall et al. reference that discloses an EPG that uses a transparent value for the background of the EPG (Fig. 9). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al, Alexander. and Alten et al. combination with the Marshall et al. transparent background color for the purpose of maintaining the full screen view of the television program while viewing the program listing for the

viewer's entertainment.

Claims 25 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A 1 of record) in view of Alexander et al. (US 6,177,931) and in further view of Macrae et al. (US 2003/0208756 A1 of record).

As to claim 25, the claimed "wherein the selected advertising message is about an upcoming television program or event." Note, the Ellis et al. reference discloses advertising messages (Ellis [0127]).

However, the Ellis et al. reference is silent as to advertising messages about an upcoming television program or event.

Now note the Macrae et al. reference that discloses a method and system for displaying targeted advertisements in an electronic program guide. The claimed "wherein the selected advertising message is about an upcoming television program or event" is met by advertisements displaying information about a future-scheduled television program" (Macrae [0214]).

Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis/Alexander. advertisements with the Macrae et al. future-programming advertisements for the purpose of promoting certain programs to a user and allowing a user to easily instruct the EPG to record the future-scheduled program (Macrae [0214]).

As to claim 32, please see rejection of claim 25.

Claims 26-27 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A 1 of record) in view of Alexander et al. (US 6,177,931) and in further view of and Schein et al. (US 2003/0208758 A1 of record).

As to claims 26 and 27, the claimed "wherein the selected advertising message is related to a sponsor of the displayed television program" and "wherein the selected advertising message promotes products and services of the sponsor." Note the Ellis et al. reference discloses an overlay with advertisements.

However, the Ellis et al. reference does not specifically disclose advertising messages relating to a television program sponsor.

Now note the Schein et al. reference that discloses a method and system for displaying panel advertisements in an electronic program guide wherein advertisement messages may advertise programs or products from program sponsors, etc. (Schein et al. [0081]).

Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. and Alexander electronic program guide advertisements with the Schein et al. program sponsor advertisements for the purpose of providing a program sponsor with an additional benefit of increasing exposure of viewers to its' products/services and an additional means revenue.

As to claims 33 and 34, please see the rejections of claim 26 and 27.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Hunter B. Lonsberry
Primary Examiner
Art Unit 2623